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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS

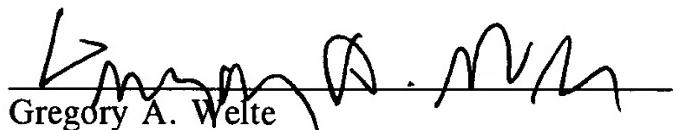
Assignee's Docket No.: 8580)
Group Art Unit: 3624)
Serial No.: 09/826,678)
Examiner: Dan Kesack)
Filing Date: April 5, 2001)
Title: Transaction Terminal)
Interface)
)

APPEAL BRIEF
A Summary of Argument Begins on Page 6

The fee for this Brief has been paid previously, for a Brief mailed December 28, 2006, in response to which prosecution was re-opened by the PTO.

CERTIFICATE OF MAILING

I certify that this document is addressed to Mail Stop AF, Commissioner of Patents, PO Box 1450, Alexandria, VA 22313-1450, and will be deposited with the U.S. Postal Service, first class postage prepaid, on February 27, 2008.



Gregory A. Welte

1. REAL PARTY IN INTEREST

NCR Corporation.

2. RELATED APPEALS AND INTERFERENCES

None.

3. STATUS OF CLAIMS

Claims 1 - 6, 8, 10, 21 - 25, and 27 are pending, rejected,

09/780,696
Art Unit 3624
Docket no. 8771.00

and appealed.

Claims 7, 9, 11 - 20, and 26 are cancelled.

4. STATUS OF AMENDMENTS

No Amendment-After-Final has been filed.

5. SUMMARY OF CLAIMED SUBJECT MATTER

The apparatus 10 of Figure 1 of the Specification is mounted within a car which a person drives. The person drives to an ATM, Automated Teller Machine, and executes a transaction using the device 10.

When the person arrives at the ATM, the ATM detects the car, and issues an interrogation signal. The apparatus 10 responds, indicating its readiness. (Specification, page 7, lines 5 - 8.)

The ATM downloads a series of programs to the apparatus 10, which generate an interface with which the person interacts. The programs are sent to the memory 24 in Figure 2, and are executed by the processor 22. (Page 7, lines 8 - 10.)

The interface replaces the function of the interface at the ATM, so that the person need not leave the car.

Mapping of Claim Elements in Independent Claims

Parenthetical phrases, in **bold typeface**, are inserted into the following independent claims, to identify matter in the

09/780,696
Art Unit 3624
Docket no. 8771.00

Specification and Figures which supports the claim language adjacent said **bold, parenthetical typeface**.

1. A method of conducting a transaction from within a vehicle, (**page 2, lines 18, 19**) the method comprising the steps of:

locating the vehicle adjacent a transaction terminal (**page 2, line 20**);

transferring one or more computer programs from the transaction terminal to an in-car data entry facility maintained within the vehicle, which programs generate a user interface in the entry facility (**page 4, lines 14 - 19**);

entering user instructions into the in-car data entry facility (**page 2, line 21**); and

transmitting the user instructions locally to the terminal for execution by the terminal (**page 2, lines 23, 24**).

8. An in-car apparatus to be provided within a vehicle for user interfacing with a transaction terminal (**Apparatus 10, Figure 1; page 2, lines 6 - 10 and 18, 19**), the apparatus comprising:

means for interacting with a user (**page 6, lines 7 - 14; Figure 1, items 12, 14, 16, 18, and 20**);

means for receiving a computer program from the

09/780,696
Art Unit 3624
Docket no. 8771.00

transaction terminal which generates an interface in the apparatus (**Figure 2, transceiver 26 and memory 24; page 7, lines 8 - 15**); and means for transmitting data locally to a transaction terminal situated adjacent the apparatus (**Figure 2, local transceiver 26; page 7, lines 12 - 16**).

21. A method, comprising:

- a) maintaining a wireless communication device within a vehicle (**page 6, lines 5 - 8**);
- b) positioning the vehicle near an Automated Teller Machine, ATM (**page 7, lines 1 - 4**);
- c) establishing wireless communication between the wireless device and the ATM (**page 7, lines 5 - 10**);
- d) entering identification data into the wireless device, which data allows the ATM to verify identity of a user (**page 7, lines 11 - 13**); and
- e) if the ATM verifies the user, proceeding with a financial transaction (**page 7, lines 12 - 16; page 3, lines 4 - 16**).

25. A method, consisting essentially of the steps of:

- a) maintaining a wireless communication device within a vehicle, said device comprising a keypad and a card

09/780,696
Art Unit 3624
Docket no. 8771.00

reader (device 10, Figure 1; page 6, lines 5, 6; Figure 1: card reader 14, keypad 16) ;

b) positioning the vehicle near an Automated Teller Machine, ATM (page 7, lines 1, 2);

c) establishing wireless communication between the wireless device and the ATM and transferring one or more computer programs from the ATM to the device, which programs generate an interface for the user (page 7, lines 5 - 10);

d) inserting a card into the card reader in response to a prompt issued by the interface (page 7, lines 11, 12);

e) entering a PIN into the keypad in response to a prompt issued by the interface (page 7, lines 12, 13);

f) relaying data from the card, and the PIN, to the ATM (page 7, lines 12, 13); and

g) if the card and the PIN are accepted by the ATM, proceeding with a financial transaction (page 7, lines 13 - 17; page 3, lines 4 - 16).

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The rejection of claims 1 - 3, 8, 10, and 27 on grounds of anticipation under 35 USC § 102, based on Dickson.

The rejection of claims 21 - 25 on grounds of obviousness

09/780,696
Art Unit 3624
Docket no. 8771.00

under 35 USC § 103, based on Dickson and DeVries.

The rejection of claims 4 - 6 on grounds of obviousness under 35 USC § 103, based on Dickson, DeVries, and Ohki.

7. ARGUMENT

SUMMARY OF ARGUMENT

Point 1

Claim 1 recites:

transferring . . . computer programs . . . to [a] . . . facility maintained within the vehicle,

which programs generate a user interface in the . . . facility.

Appellant points out that

- "programs" are transferred and
- they "generate a user interface."

In a Dickson reference, a terminal in a vehicle orders gasoline, fast food, and other things at a convenience store. The convenience store transfers menu-data to the terminal, such as the price of hamburgers. The Final Action relies on the menu-data as showing the claimed "programs."

Menu-data, which states the price of hamburgers, is not a "program." The claimed "program" is not shown in the reference.

09/780,696
Art Unit 3624
Docket no. 8771.00

Point 2

The Final Action admits that Dickson transfers "data," but asserts that the term "program" in the claim can be extended to cover the "data," on the grounds that

. . . the data . . . in Dickson instructs the device as to what should be displayed on the interface. (Final Action, page 5, third sentence.)

However, several problems exist in this assertion.

Problem 1

The assertion does not apply a proper definition of "program." One definition is "a sequence of instructions which runs on a microprocessor." The data in Dickson contain no "instructions which run on a microprocessor."

Problem 2

Under the Final Action's definition, a television signal is a "program," because it determines what a television displays.

But nobody thinks that a television signal is a "program."

The Final Action's definition is erroneous.

Numerous similar examples are given herein. ("PROBLEM 5," near page 27.)

09/780,696
Art Unit 3624
Docket no. 8771.00

Problem 3

The assertion contradicts the claim. The assertion states that the "data" "instructs" the "interface." Thus, the "interface" is pre-existing in the vehicle.

The claim states that the transferred "programs" "generate" the "interface."

Problem 4

The Final Action, page 5, states "Programs may be anything which instruct a computer." This is incorrect. Programs do not "instruct" a computer. Programs **RUN** on a computer, or microprocessor.

Further, the phrase "instruct a computer" is non-standard, and lacks meaning.

Problem 5

The Final Action's definition of "program," as in Problem 4, above, is inapplicable to the claimed subject matter.

In Dickson, the data is transferred to a computer/program **combination**. The program accepts the data, and displays it.

Thus, the "data" in Dickson does not actually "instruct" the computer. The "data" is given to a program which contains the instructions, and **the program** displays the data according to

09/780,696
Art Unit 3624
Docket no. 8771.00

those instructions.

Again, there is no "program" which is "transferred" and which "generates" an "interface."

Problem 6

As explained above, the "data" in Dickson is the price of hamburgers, and the like. Plainly, that data is accepted by the program/computer combination in the vehicle, and inserted into the proper place in a menu which is displayed.

Thus, at best, the data controls **PART OF** the display. That does not show the claim, which states

transferring . . . computer programs . . . to
[a] . . . facility maintained within the
vehicle,

which programs generate a user interface in
the . . . facility.

Problem 7

In this situation, the MPEP requires that the Final Action set forth the definition of "program" which is being used. That has not been done.

Point 3

Assume the Final Action is correct, and Dickson transfers a "program" which "instructs" Dickson's IVC on what to display.

09/780,696
Art Unit 3624
Docket no. 8771.00

The claim does not recite that. The claim recites a "program" which "generates an interface."

That is, if the Final Action is correct, it has merely shown a "program" in Dickson, but the claim recites a **different** program.

Point 4

The Final Action is asserting that any **input** to a computer is a "program." The Final Action, page 5, fourth sentence, states "Programs may be anything which instruct a computer . . ."

Appellant points out that a mouse delivers signals which "instruct" a computer. Nobody considers those signals to be a "program."

A similar comment applies to keyboard input and incoming e-mail messages.

Point 5

As explained herein, the data of Dickson can be handled without any involvement of a microprocessor.

In brief: the data can be received by a DMA (Direct Memory Access) device, and loaded into video RAM. Then, a graphics card reads the data from video RAM and causes the display to present the data (eg, the current price of hamburgers).

The microprocessor is not involved. Thus, the data cannot

09/780,696
Art Unit 3624
Docket no. 8771.00

be a program.

Further, this type of design saves microprocessor time, and allows a cheaper microprocessor to be used, because the microprocessor is not involved in handling the data in question.

"Program" in Remaining Claims

The discussion above, regarding transfer of a "program," applies to the remaining claims, except claim 21.

Claim 8

Claim 8 contains a "means-plus-function" element:

means for receiving a computer program from the transaction terminal which generates an interface in the apparatus.

Under section 112, the subject matter in the reference showing this "means" must "correspond" to that in Appellant's Specification, or be "equivalent" thereto.

The Specification, page 7, lines 8 - 10, states:

A series of computer programs are then transferred from the terminal 32 to the memory 24 . . . , where **processor 22 executes the programs** to generate an appropriate interface environment for the particular transaction type.

If the data in Dickson is to show the claimed "program,"

09/780,696
Art Unit 3624
Docket no. 8771.00

then Dickson's data must be

- 1) transferred to "memory,"
and then
2) "executed" on a "processor" in Dickson.

That has not been shown.

Obviousness Rejections

No valid teaching has been given for combining the references. The rationale given is that a "more functional in-car transaction device" is obtained. (Page 6, Office Action mailed June 19, 2007, incorporated into Final Action on page 3, section 6 of latter.)

Several problems exist in this rationale.

Problem 1

The phrase "more functional" has no meaning. Something either "functions" or it does not. The Final Action has not explained how degrees of "function" can exist, or how one compares those degrees.

By analogy, the term is like the term "pregnant." Nobody is "more" pregnant than someone else.

If a statement has no meaning, then it cannot be verified. Non-verifiable statements cannot act as a rationale for combining references.

09/780,696
Art Unit 3624
Docket no. 8771.00

Problem 2

If the phrase means that the combined references have "more" "functions" than something else, then additional issues arise.

ISSUE 1

Those functions have not been identified. The rationale is a naked conclusion, unsupported by evidence.

Further, until the functions are identified, the truth or falsity of the statement cannot be verified.

ISSUE 2

The Final Action has shown no logical connection between (1) the pursuit of "more functions" and (2) the claimed invention. That is, by what mechanism does the pursuit of "more functions" actually lead to the claimed invention ?

ISSUE 3

It appears that the rationale is actually false. When the in-car device of Dickson is substituted into the other reference (DeVries), the other reference is then restricted to using stationary terminals of the Dickson-type, that is, terminals which transfer Dickson's menu-data.

Previously, the in-car devices in DeVries could use more

09/780,696
Art Unit 3624
Docket no. 8771.00

terminals than that.

Thus, the number of places where DeVries can now make purchases is reduced. That is a **reduction** in number of "functions."

ISSUE 4

This rationale has not been shown in the prior art. MPEP § 706.02(j) states:

Contents of a 35 U.S.C. 103 Rejection

. . .
To establish a prima facie case of obviousness, three basic criteria must be met.

First, there must be some suggestion or motivation, **either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.**

. . .
The teaching or suggestion to make the claimed combination . . . **must . . . be found in the prior art** and not based on applicant's disclosure.

Problem 3

Assuming that "more functional" has meaning, the rationale is not a teaching under section 103. The rationale merely points out a **characteristic** of the combination of references, but **after**

09/780,696
Art Unit 3624
Docket no. 8771.00

combining them.

That is not a teaching for making the combination in the first place.

Further, the mere presence of a characteristic in a combination of references cannot act as a teaching under section 103. One reason is that **every** combination has some characteristics or other. If the presence of a characteristic acts as a teaching, then every invention would be obvious, because every invention is composed of individual elements which are found in the prior art.

Comment

Not all points in this Summary are elaborated below. Some are considered self-explanatory.

END SUMMARY

ARGUMENT IN FULL

RESPONSE TO ANTICIPATION REJECTIONS OF CLAIMS 1 - 3, 8, 10, AND 27

Claims 1 - 3, 8, 10, and 27 were rejected on grounds of anticipation, based on Dickson.

Claim 1

Claim 1 recites, in part:

09/780,696
Art Unit 3624
Docket no. 8771.00

locating the vehicle adjacent a transaction terminal;

transferring one or more computer programs from the transaction terminal to an in-car data entry facility maintained within the vehicle, **which programs generate a user interface in the entry facility.**

To repeat, the claim states that

- "programs" are transferred to the "data entry facility" "within the vehicle," and
- the "programs generate a user interface in the entry facility."

No such "programs," which "generate a user interface," are found in Dickson.

Dickson Reference

Dickson shows a drive-in convenience store, wherein vehicles enter and the driver-customers can make purchases, using an IVC, In-Vehicle Controller. (Column 6, lines 5 - 10; column 2, line 2.)

PTO's Application of Dickson

The Office Action cites Dickson passages at, column 18, lines 15 - 17 and lines 28 - 40, as showing the claimed transfer of programs..

09/780,696
Art Unit 3624
Docket no. 8771.00

These passages, and nearby passages, refer to the IVC, and state that

-- "menu information" is transferred to the IVC, and

-- the IVC may retain the "menu information" for future transactions at the convenience store (thereby eliminating the requirement of another transfer).

POINT 1

Dickson states that "menu information," that is, **data**, is transferred to the IVC.

In contrast, the claim recites "programs" which "generate a user interface."

The **data** of Dickson does not correspond to the claimed "programs."

By analogy, the PTO is confusing

-- a word-processing **program**

with

-- a word processing **document**,

which the program would generate, display, and print. The **program** has completely different properties than does the **document**.

A **program** runs on a microprocessor. The program's content,

09/780,696
Art Unit 3624
Docket no. 8771.00

namely, the instructions, must conform to the rules of syntax and programming established by the designer of the microprocessor.

Such stringent requirements do not apply to data, such as a word processor document. In fact, a word processor document can be pure gibberish, which makes no sense at all, and yet be accepted by the word processor program.

POINT 2

As stated above, Dickson's IVC may retain the menu **data** for later use. Dickson states that, when the customer returns at a later time, that retained **data** is updated by **new data**, if necessary, for example, when prices change. (Column 18, lines 33 - 36.)

Clearly, this updating shows that Dickson transfers **data**, not a "program" as claimed. The updating transfers new information, that is, new data.

POINT 3

If Dickson were to transfer a "program," Dickson would need to know the type of microprocessor running in the IVC being used by the customer. The reason is that different microprocessors utilize different instruction sets, so that a program written for one microprocessor will not run on another microprocessor.

As a specific example, Apple computers using microprocessors

09/780,696
Art Unit 3624
Docket no. 8771.00

manufactured by Motorola (or equivalent) cannot run programs written for IBM PCs, which use microprocessors manufactured by Intel (or equivalent).

The undersigned attorney can find no discussion in Dickson wherein he states that he identifies the type of IVC used by the customer.

Therefore, it is reasonable to conclude that Dickson does not transfer a "program" as claimed. He transfers **data**.

POINT 4

Dickson states, and implies, that literally hundreds of different types of IVCs can be used. (Column 7, lines 43 - 55.) Thus, hundreds of different types of microprocessors can be expected.

In order for Dickson to be operative to transfer "programs," as claimed, he must, as a minimum,

- identify each type of microprocessor,
- maintain a program for each type of microprocessor,
- select the appropriate program, based on the identification, and
- transfer the selected program.

The undersigned attorney can find a discussion of none of this in Dickson.

09/780,696
Art Unit 3624
Docket no. 8771.00

Thus, Dickson is non-enabling for the process of transferring a program to the IVC, which program generates a user interface.

For a reference to be anticipatory under section 102, the reference must be enabling. (See Patents by D. Chisum, sections 3.06(1)(a) and 304(1). Copies were attached to Appellant's previous amendment.)

Since Dickson is non-enabling on the process of transferring programs to the IVCs, Dickson cannot anticipate.

POINT 5

As stated above, Dickson states that he updates the retained menu-data, as when prices change.

If that retained data were a "program," as claimed, then the updating requires at least two steps:

- 1) later transferring an update for the program and
- 2) incorporating the update into the retained program.

There is no enablement in Dickson for this two-step process.

In general, the process of modifying a computer program is very complex, and it is doubtful that Dickson performs it. In any case, he does not discuss it.

Further, he would have to maintain a collection of update-

09/780,696
Art Unit 3624
Docket no. 8771.00

programs, one for each of the hundreds of microprocessors discussed above. He does not discuss that, and does not show enablement for that.

Therefore, if Dickson's updates (column 18, line 35) are interpreted as updates to computer programs, Dickson is non-enabling for such an interpretation.

If he is non-enabling, he cannot anticipate.

POINT 6

Dickson states that his IVC is integrated with the on-board computer system of the vehicle, which controls engine functions. (Column 11, lines 19 - 21.)

It is unreasonable to assume that a "program" is downloaded into the IVC, as the Final Action asserts, because of the self-evident possibility of infecting the vehicle's computer with a virus.

The financial liability of the operator of Dickson's system would be enormous, if a downloaded "program" caused a malfunction in the automobile to which the download occurred.

It is unreasonable to interpret Dickson as downloading a "program," rather than the data which he mentions.

POINT 7

The "interface" of the IVC is already present in the vehicle

09/780,696
Art Unit 3624
Docket no. 8771.00

of Dickson. That is, the software and hardware necessary for the customer to purchase gasoline, without the download of the "data" upon which the Final Action relies, is already present in the vehicle. (Column 9, line 31 - column 10, line 31; column 11, lines 9 - 18; column 11, lines 20 - 22.)

Consistent with this conclusion (that the necessary program is already present in Dickson's IVC), the "data" upon which the Final Action relies is that represented by block 502 in Dickson's Figure 11A. However, that Figure represents a flow chart of a computer program, already present in the vehicle, which is executed by equipment already present in the vehicle.

The "data" of block 502 is received by that program.

The "data" is not a "program."

POINT 8

It appears that Dickson transfers data to his IVC, but without any involvement of the IVC's microprocessor. If so, then the data cannot be a "program," because a "program" must run on a microprocessor.

Appellant submits that what probably happens in Dickson is the following.

09/780,696
Art Unit 3624
Docket no. 8771.00

What Happens in Dickson

BACKGROUND

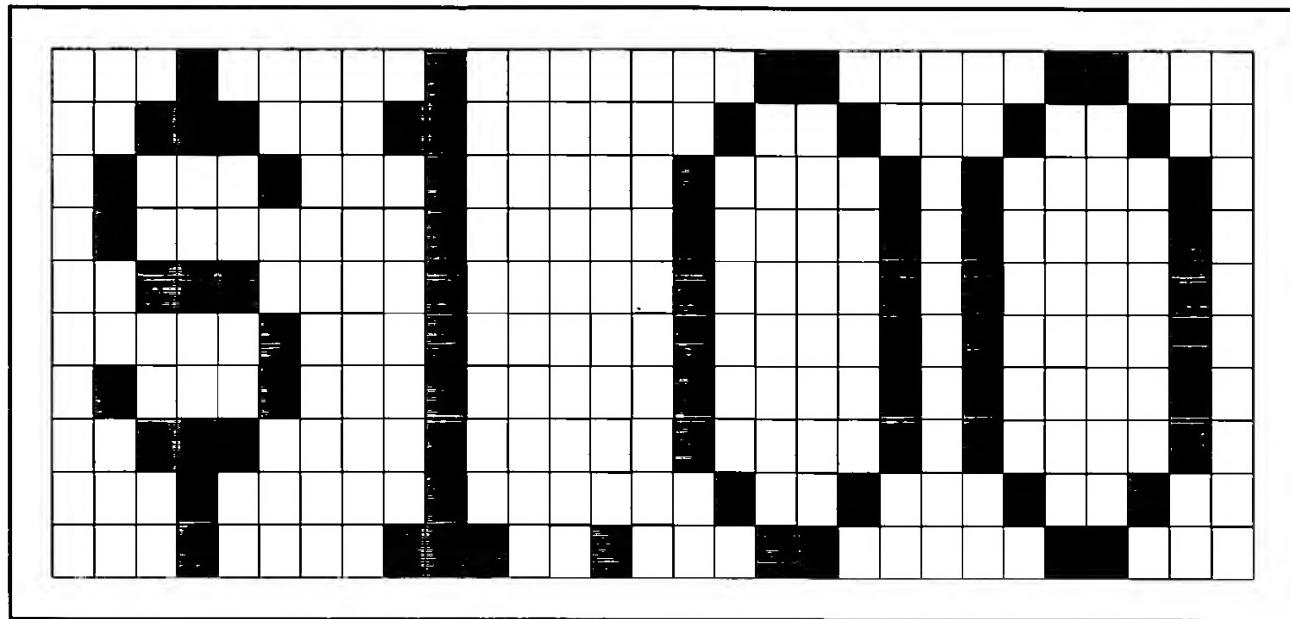
A display in a computer contains pixels. For example, a 480 x 640 display contains over 300,000 pixels. Assume a monochrome display, wherein each pixel is either white or black.

The display is controlled by a section of memory which is called "video RAM," and other names such as "frame buffer." The video RAM contains a memory location for each pixel. A video driver, or "graphics card" reads the video RAM, and handles the details of actuating each pixel in the display.

In this example, if a pixel is to be white, the corresponding memory location will be loaded with a logical ONE. That is, a single bit of value "1" is loaded. Conversely, if the pixel is to be black, a logical ZERO is loaded.

If the price of hamburgers (such as "\$ 1.00") is assigned a specific location on the display, then the appropriate bits in video RAM are loaded with the proper data, to represent "\$ 1.00". This is illustrated graphically in the following picture, wherein each square represents a pixel, and also a memory location in video RAM.

09/780,696
Art Unit 3624
Docket no. 8771.00



WHAT DICKSON DOES

Dickson accepts the menu-data, and loads it into the video RAM. This can be handled by a DMA (Direct Memory Access) device. From there, the graphics card handles generation of the price of hamburgers on the display.

If this occurs in Dickson, then the processor is not involved. The data which is transferred does not "run" on the computer, and thus is not a "program."

The Final Action must show that the data "runs" on the processor in Dickson, and that has not been done.

Response to Final Action

The Final Action now admits that a "program" is **not downloaded** in Dickson, but "data" is. However, the Final Action now asserts that the definition of "program" should be expanded,

09/780,696
Art Unit 3624
Docket no. 8771.00

to cover the data which Dickson downloads.

The Final Action, page 5, first paragraph, states:

The **data** which is transmitted to the IVC in Dickson instructs the device as to what should be displayed on the interface, and is considered by the Examiner to be a program.

(Emphasis supplied.)

Appellant points out that several problems exist in this assertion.

PROBLEM 1

The Final Action re-words a correct statement into an incorrect statement, to give the appearance that a "program" is transferred in Dickson.

The incorrect statement is this:

The data which . . . instructs the device as to what should be displayed . . . is considered . . . to be a program.

However, the statement is incorrect because no data "instructs the device."

The data in question is simply **input data** to the program(s) which are running on Dickson's IVC. Once that revelation is uncovered, the error becomes clear. The Final Action is actually asserting something like this:

09/780,696
Art Unit 3624
Docket no. 8771.00

The input data given to Dickson's program in the IVC is considered to be a program, because the input data influences how a display is generated.

The Final Action re-words this correct statement into an incorrect statement which is intended to give the impression that a "program" is transferred.

But input data is not a program. It is data.

To repeat: the input data in Dickson is delivered to a computer/program combination. That computer/program combination inserts the input data onto a display.

PROBLEM 2

The input data in Dickson is clearly information which is found on a restaurant menu. (Column 18, line 15 et seq.) The data specifies

- the price of hamburgers,
- the price of milk shakes,
- etc.

Plainly, the computer/program combination which receives the data inserts that data into a larger display-image, which the computer/program generates on a screen.

This conclusion is supported by the common-sense fact that the owner of the convenience market in which Dickson's invention

09/780,696
Art Unit 3624
Docket no. 8771.00

is installed will not be given the task of programming a computer, to generate screen displays. The owner only supplies simple items of data, which the computer/program combination accepts, and incorporates into the display.

Therefore, the data in Dickson only determines a **small part** of the overall display. Thus, it is incorrect for the Final Action to assert that "The data . . . instructs the device as to what should be displayed."

In fact, the "data" only influences a **small part** of what is displayed. And it does that by acting as input to a program running in the IVC, namely, that program flowcharted in Dickson's Figure 11A.

PROBLEM 3

Even if the Final Action's statement be correct (contrary to Appellant's assertions in PROBLEMS 1 and 2), the claim recitation is still **not shown** by Dickson.

The claim does not recite "instructing" what is displayed in Dickson.

The claim recitation is this:

. . . transferring one or more computer programs . . . which . . . generate a user interface in the entry facility . . .

That is, the transferred "programs generate a user interface

09/780,696
Art Unit 3624
Docket no. 8771.00

in the entry facility." The "facility" is located in the vehicle.

The Final Action asserts that the "data" in Dickson "instructs the device as to what should be displayed on the interface."

However, the claim does not recite that. The claim states that the "programs" transferred "generate a user interface."

Appellant repeats:

-- The Final Action asserts that Dickson's data determines ("instructs") what should be displayed.

-- The claim states that the "programs" transferred "generate a user interface."

Transferring data which determines/instructs what is displayed, as in Dickson, does not show "programs" which "generate a user interface," as claimed.

PROBLEM 4

The Final Action pre-supposes that, in Dickson, an "interface" is already present in the IVC, within the vehicle. The Final Action expressly states that the "data" determines what is to be displayed on that "interface." The "interface" is **already there.**

But the claim states that the transferred "programs"

09/780,696
Art Unit 3624
Docket no. 8771.00

"generate a user interface."

How can Dickson "generate a user interface" when the "interface" is already present ?

PROBLEM 5

The Final Action re-defines the word "program." It defines "program" as something that "instructs" a "device as to what should be displayed."

In essence, the Final Action is asserting that anything that causes something to be displayed on a "device" is a "program." That means that **almost everything** is a "program." The following examples illustrate this conclusion.

Under this definition, input from a computer keyboard is a "program." The input controls what is displayed on a video screen.

Under this definition, a music CD is a "program," when played in Microsoft Windows Media Player (MWMP). The reason is that MWMP displays a kaleidoscopic light-show when a song is playing. Thus, under the Final Action's assertion, the music CD is a "program."

Under this definition, a television signal is a "program." It creates images on a television screen.

Under this definition, a speedometer cable in an automobile is a "program," because it "instructs" the needle on the

09/780,696
Art Unit 3624
Docket no. 8771.00

dashboard what to display.

Under this definition, a thermocouple in an electronic thermometer is a "program," because it "instructs" the numerical read-out "what to display."

Under this definition, data on a telephone line which feeds a "caller ID" display is a program, because the data causes a caller's telephone number to be displayed.

And so on.

Appellant submits that the Final Action's definition is completely erroneous. The mere fact that something "instructs" something else as to what to "display" does not make that "something" a "program."

This is particularly so in Dickson because the "something" in question is data which is fed to a **pre-existing program** in his IVC. **THAT** program determines what is displayed.

PROBLEM 6

In concluding that Dickson shows the claimed "program," the Final Action fails to comply with the MPEP.

MPEP § 2164.04 states:

For terms that . . . could have more than one meaning, it is necessary that the examiner

select the definition that he/she intends to use when examining the application, based on his/her

09/780,696
Art Unit 3624
Docket no. 8771.00

understanding of what applicant
intends it to mean,

and

**explicitly set forth the meaning of
the term and the scope of the claim
when writing an Office action.**

The Final Action has not followed this MPEP section. The Final Action has not set forth "the meaning of the term" "**program**", as required.

Instead, the Final Action has merely asserted the unsupported conclusion that the data in Dickson qualifies as a "program."

PROBLEM 7

The Final Action, page 5, states "Programs may be anything which instruct a computer." However, no support for this assertion has been given. Support is required.

Support is required for the simple reason that the statement is so broad as to be plainly incorrect. The undersigned attorney owns a laptop computer, which has a cordless, infra-red (IR) mouse. Movement of the mouse causes IR signals to be sent to the computer, causing a cursor to move on the display. "Clicking" a mouse button causes other IR signals to be sent, causing other actions.

Under the Final Action's view, these IR signals are

09/780,696
Art Unit 3624
Docket no. 8771.00

"programs," because they "instruct a computer."

That view is not orthodox, and cannot be accepted without a citation of authority.

Similarly, speech recognition programs exist, which accept spoken words as input, and cause a computer to respond according to the spoken words, or to print the words which are "heard" by the program. Under the Final Action's view, these spoken words are "programs." That view is, again, heterodox.

Conclusion

No "program" is transferred as recited in claim 1. The item in Dickson relied on to show the claimed "program" is the data of block 502 in his Figure 11A.

That **data** is **INPUT** to a program in Dickson's IVC.

Input is not a "program." It is input data.

Other Claims

The discussion above applies to the other claims in this group.

Claim 27

POINT 1

Claim 27, and its parent claim 1, state that the vehicle is positioned at first and second terminals (at different times, of

09/780,696
Art Unit 3624
Docket no. 8771.00

course).

The Final Action has not shown that Dickson states that a given IVC can be used at two different terminals.

POINT 2

Under claim 27, first programs are transferred at the first terminal, and second programs are transferred at the second terminal. This operation has not been shown in Dickson.

POINT 3

As explained herein, Dickson sometimes, and perhaps most of the time, stores menu-data in the IVC, and does not transfer it when the IVC returns to a terminal. Thus, even assuming that Dickson shows the items in Point 2, above, the following possibilities exist:

- | | | | |
|----|-------------------------|---|-----------------|
| 1) | IVC visits 1st terminal | - | Transfer occurs |
| 2) | IVC visits 1st terminal | - | No transfer |
| 3) | IVC visits 2nd terminal | - | Transfer occurs |
| 4) | IVC visits 2nd terminal | - | No transfer |

In these possibilities, items (1) and (3) must be shown in Dickson, to show the claim. That has not been done.

POINT 4

The claim states that the second interface is different from

09/780,696
Art Unit 3624
Docket no. 8771.00

the first. The Final Action, page 3, asserts that this is "inherent" in Dickson.

MPEP § 2112 states:

EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE TENDING TO SHOW INHERENCY.

In relying upon the theory of inherency, the examiner must provide a **basis in fact and/or technical reasoning** to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art.

No "basis in fact and/or technical reasoning" has been provided, as required by this MPEP section.

Appellant points out that, in Dickson, the same IVC would be used at both terminals. The same program will be present in that IVC at both locations. If new menu-data is loaded into the IVC at the second terminal (which has not been shown), then the only difference will be that of menu-prices displayed.

That difference (which has not been shown) does not necessarily mean that the "a second user interface" is "different from said [first] interface."

Appellant points out that, under the claim, the "interfaces" are generated by the "programs" which are transferred. The claim states that "first" and "second" programs are transferred.

"Programs" are not transferred in Dickson, which generate the interfaces. Thus, any differences are not due to "programs."

09/780,696
Art Unit 3624
Docket no. 8771.00

Claim 8

The discussion of claim 1 applies to claim 8.

In addition, claim 8 recites:

. . . means for receiving a computer program from the transaction terminal which generates an interface in the apparatus . . .

This is a "means-plus-function" phrase. Section 112 states:

An element in a claim for a combination may be expressed as a means . . . for performing a specified function . . .

and

such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

POINT 1

The Specification discusses items which "correspond" to the claim, on page 7, lines 8 - 10:

A series of computer programs are then transferred from the terminal 32 to the memory 24 . . . , where processor 22 executes the programs to generate an appropriate interface environment for the particular transaction type.

The Final Action relies on the data of Dickson's block 502 in his Figure 11A to show the claimed "program."

09/780,696
Art Unit 3624
Docket no. 8771.00

If that data qualifies as the claimed "program," then the data must "run" on a processor, in order to "correspond" with Appellant's Specification.

However, in Dickson, nothing which "runs" the data, to generate "an interface in the apparatus" has been shown. Nor has an "equivalent" been shown.

POINT 2

As explained above, Dickson states that his menu-data is not transferred for every transaction. It can be saved by the IVC for a later transaction. (Column 18, lines 28 - 36.)

That does not correspond to Appellant's Specification.

RESPONSE TO OBVIOUSNESS REJECTIONS **CLAIMS 21 - 25**

Claims 21 - 25 were rejected as obvious, based on Dickson and DeVries.

Claim 21

Point 1

No valid teaching has been given for combining the references.

The rationale given is that the combined references provide a "more functional in-car transaction device."

09/780,696
Art Unit 3624
Docket no. 8771.00

However, this rationale, in essence, asserts that certain properties of the combination of references are desirable, and thus the references should be combined for that reason.

However, that is not a teaching for combining the references in the first place. That merely points to supposed properties of the references, once combined.

If this type of rationale suffices as a teaching under section 103, then almost all, and possibly all, inventions ever made would be obvious. The reason is that all inventions have some properties or other which are considered desirable.

Therefore, the mere presence of desirable properties in the combination of references is not a basis for rejection under section 103.

Point 2

Appellant submits that the rationale is a meaningless statement, and thus cannot be used.

Something either "functions" or it does not. The Final Action has not explained how degrees of "function" exist, so that something can be "more functional" than another thing.

It could be that "more functional" means that **more** "functions" are provided by the combined references.

-- If so, where is the teaching in the prior art that this is desirable ?

09/780,696
Art Unit 3624
Docket no. 8771.00

-- If so, Appellant is entitled to request that those functions be identified, so that he can verify whether, in fact, "more" "functions" are attained. Until the functions are identified, the rationale is merely an unjustified conclusion.

-- If so, then the Final Action is combining references, merely for the sake of combining them. That is, in essence, the reason for the combination is to add the "functions" of one reference to another, to attain a "more functional" device. That is not the standard for a teaching of obviousness.

Point 3

The MPEP requires that the teaching be found in the prior art. MPEP § 706.02(j) states:

Contents of a 35 U.S.C. 103 Rejection

. . .

To establish a prima facie case of obviousness, three basic criteria must be met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the

09/780,696
Art Unit 3624
Docket no. 8771.00

art, to modify the reference or to combine reference teachings.

. . .
The teaching or suggestion to make the claimed combination . . . must . . . be found in the prior art and not based on applicant's disclosure.

But the rationale points to **properties** of the combined references as a justification for combining the references.

That is, the references are combined in order to obtain those **properties**.

But those properties have not been identified in the prior art. The PTO has not shown its justification in the prior art, as required.

Point 4

The Final Action, page 6, asserts that one in possession of Dickson would look to similar references for features to add to Dickson.

Appellant points out that this is not the test of obviousness.

One does not equip the hypothetical person skilled-in-the-art with a reference, and then commission that person to improve the reference.

09/780,696
Art Unit 3624
Docket no. 8771.00

Point 5

The Final Action relies on the KSR decision. Appellant points out that, under the rules of precedent, the KSR decision is limited to its facts (as are all court decisions).

In KSR, the references contained all teachings needed to produce the claimed invention. Nothing was needed from the Examiner.

Specifically: in KSR, claim 4 was in issue. The Court held that all elements of claim 4 were taught in a single reference (Asano), with one exception. That exception was a sensor, which sensed position of a movable pedal, but which itself was fixed in position. (550 U.S. at 7, 18.)

However, a Smith patent taught that the sensor should be stationary, to avoid chafing of wires attached to a sensor which moved. (550 U.S. at 4.)

The court held that everything needed to produce claim 4 was found in Asano and Smith. (550 U.S. at 18.)

No additional teachings were required.

That is different from Appellant's situation. The motivation for combining the references are not found in the references themselves. The motivation was provided by the Examiner.

09/780,696
Art Unit 3624
Docket no. 8771.00

Point 6

KSR is limited to a situation involving "a patent claiming the combination of elements of prior art . . ." (550 U.S. at 13, last full paragraph.)

This is not trivial: the "elements" "combined" must be found in the prior art.

In Appellant's situation, as explained above, the element of downloading a "program" which generates an "interface" has not been shown in the prior art.

The Final Action is not combining elements found in the prior art. KSR is distinguishable on its facts.

Point 7

The Final Action cites KSR for the proposition that a "specific teaching" is not required. That is not correct.

The court in KSR stated:

Often, it will be necessary for a court to look to

interrelated teachings of multiple patents;

the effects of demands known to the design community or present in the marketplace; and

the background knowledge possessed by a person having ordinary skill in the art,

all in order to determine whether there was

09/780,696
Art Unit 3624
Docket no. 8771.00

an apparent reason to combine the known elements in the fashion claimed by the patent at issue.

To facilitate review, this analysis should be made explicit.

. . .

" [R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." [Citation.]

The court then stated that "precise teachings directed to the specific subject matter of the challenged claim" need not be found in the references.

But teachings are still required. They can be found in the "inferences and creative steps that a person of ordinary skill in the art would employ." (550 U.S. at 14, end of first paragraph.)

In essence, the Final Action is asserting that its rationale that the combination of references is "more functional" than something else qualifies as the "inferences and creative steps . . ." of KSR. But that rationale is the Final Action's fabrication.

-- It has not been shown in the prior art.

-- No evidence has been given that the "skilled person" believes in that rationale.

09/780,696
Art Unit 3624
Docket no. 8771.00

Point 8

The combination of references renders DeVries inoperative.

MPEP § 2143.01, section 5, states:

The proposed modification cannot render the prior art unsatisfactory for its intended purpose.

DeVries shows a device in a vehicle which allows the driver to make purchases. He states that his system is usable at numerous types of locations, including "drive-through fast food sales," and "drive-through bank transactions, and the like." (Column 2, lines 2 - 4.)

Under the combination of references, "data" must now be downloaded into the device of Dickson, which was substituted into DeVries. However, now the transactions of DeVries cannot occur, because the locations where the transactions occur do not have a facility for downloading the "data" into the device of Dickson.

The combination is inoperative, and the mode of operation of DeVries has been altered.

Point 9

As explained above, Dickson does not transfer the menu-data every time. Sometimes he does not. And it is possible that **most of the time** he does not.

Thus, two operations are present in Dickson:

09/780,696
Art Unit 3624
Docket no. 8771.00

- 1) a customer purchase **without** menu-data transfer
- and
- 2) a customer purchase **with** menu-data transfer.

The Final Action is combining one of these operations (item (2)) with the other reference.

But no teaching has been given for selecting that operation, to the exclusion of the other operation.

A teaching is required for selecting an item in a reference, and combining the selected item with another reference.

Point 10

The references are contradictory, as explained in Point 2, below, in connection with claim 22.

Conclusion

Appellant thus submits that the rejection of claim 21 cannot stand.

Claim 22

The discussion of parent claim 21 applies here.

Also, claim 22 recites transfer of a computer program to a device in a vehicle. The Office Action asserts that Dickson

09/780,696
Art Unit 3624
Docket no. 8771.00

shows the claimed transfer of computer programs.

Point 1

Applicant believes that the discussion above indicates that the claimed transfer of computer programs is not shown in Dickson. Thus, even if the references are combined, the claimed transfer of programs is not found. MPEP § 2143.03 states:

To establish prima facie obviousness . . .
all the claim limitations must be taught or suggested by the prior art.

Point 2

The references are contradictory.

DeVries discusses an interface in the device which is mounted in his vehicle. It is clear that (1) no programs are transferred to that interface, and (2) the interface requires no transfer of programs. (See column 5, line 57 et seq.; column 9, line 15 et seq.)

Thus, DeVries teaches away from the concept of transferring programs to the device within the vehicle, and thus contradicts the supposed teaching of program-transfer found in Dickson.

Claims 23 and 24

Claims 23 and 24 are considered patentable, based on their

09/780,696
Art Unit 3624
Docket no. 8771.00

parent claims.

Claim 25

Point 1

Claim 25 is "consisting essentially of" type (as opposed to "comprising" type). The Final Action, page 6, asserts that the transitional phrase "consisting essentially of" can be ignored. However, several problems exist in this assertion.

PROBLEM 1

The PPG decision, cited by the Office Action, states:

By using the term "consisting essentially of," the drafter signals that the invention necessarily includes the listed ingredients and is open to unlisted ingredients that do not materially affect the basic and novel properties of the invention.

A "consisting essentially of" claim **occupies a middle ground** between ["consisting" and "comprising" claims].

(CAFC opinion 97-1513, section II, first paragraph.)

The Final Action is not following the opinion. The Final Action refuses to acknowledge the "middle ground" set forth in the opinion. Instead, the Final Action invokes the "comprising" extreme, which is only one border of the "middle ground."

09/780,696
Art Unit 3624
Docket no. 8771.00

PROBLEM 2

The Final Action has not actually shown a system which is produced by the combination of references. The Final Action has only asserted that individual claim elements are found in the two references.

Thus, it cannot be determined whether any non-claimed material in that system lies outside the "consisting essentially of" limitations, which are explained in Problem 3, below.

Problem 3

In a "consisting essentially of" claim, the question is whether the non-claimed elements, in the subject matter to which the claim is compared, have a "material effect on the basic and novel characteristics" of the claimed invention.

The PPG decision, cited by the Final Action, states:

The jury was instructed that "consisting essentially of" means that the claimed . . . invention has in it the ingredients that are specifically identified in the claim.

Other ingredients may also be present in the glass, although not specifically identified in the claim, so long as those other unlisted ingredients do not have a material effect on the basic and novel characteristics of the glass.

(CAFC opinion 97-1513, section II, second paragraph.)

09/780,696
Art Unit 3624
Docket no. 8771.00

The CAFC held that the jury instruction was correct. It stated:

The [district] court properly left it to the jury to determine whether the amounts of iron sulfide in [the infringing] glass have a material effect on the basic and novel characteristics of the glass.

(CAFC opinion 97-1513, section II, last paragraph.)

Therefore, the question is whether the combined references contain elements which "have a material effect on the basic and novel characteristics of" the claimed invention.

What are the 'basic and novel characteristics' of the claimed invention ?

As discussed above, the claimed ATM transfers programs to an in-vehicle device, which programs generate an interface.

Appellant's Specification refers to an ATM, Automated Teller Machine, at page 1, lines 5 and 9. The Specification repeatedly refers to a terminal which dispenses cash, such as an ATM:

page 3, lines 24 and 27;

page 4, line 21;

page 6, line 26, which refers to a media dispenser 38 in Figure 2, which is a generic cash dispenser;

page 7, line 18; and

09/780,696
Art Unit 3624
Docket no. 8771.00

original claim 4.

Plainly, the "basic and novel characteristics" of claim 25 include an ATM which dispenses cash, and transfers the programs recited above.

These "characteristics" do not include the gas station, nor the convenience store, of Dickson.

The combined references contain numerous elements which are outside those recited in the claim, and which alter the "basic and novel characteristics" of the invention.

-- Requiring an ATM customer to visit a gas station alters the invention.

-- Requiring an ATM customer to visit a convenience store alters the invention.

-- Requiring an ATM customer to receive downloaded menu-data, which states the price of hamburgers, alters the invention.

Point 2

Claim 25(d) and (e) recite "prompts" which are issued by the "interface."

The Final Action admits that the "prompts" are not found in the combined references. (Page 4, second paragraph.)

The Final Action relies on Official Notice to show the "prompts."

09/780,696
Art Unit 3624
Docket no. 8771.00

However, the Noticed subject matter does not show the claimed "prompts." The Noticed subject matter is that an ATM issues the "prompts." The claim does not state this. The claim states that the in-car "interface" issues the "prompts."

Restated: the Noticed "prompts" are displayed on a video screen which is fastened to an ATM. The claim states that the in-car "interface" issues the "prompts."

The claimed "prompts" appear **IN THE VEHICLE**, not on an ATM external to the vehicle.

Further, the Notice is contrary to claim 25(f), which states that the data input, in response to the "prompts," is "relayed" to the ATM. Under the Noticed subject matter, there is no need for such a "relay." Under the Noticed subject matter, the ATM receives the data directly.

Point 3

No valid teaching has been given for combining the Noticed subject matter with the other two references.

The rationale given simply sets forth the effects which the Noticed "prompts" have in an ATM. That does not lead to a combination of the references. If you want those effects, then simply use the Noticed ATM. There is no reason to combine the references to attain those effects.

In addition, as explained above, even if the Noticed ATM is

09/780,696
Art Unit 3624
Docket no. 8771.00

combined with the other references, the "prompts" of claim 25(d) and (e) are not attained.

Point 4

It appears that the Final Action is making an incorrect rejection. DeVries discusses a "cash" "machine" of a "bank." (Column 5, lines 40 - 41.)

The Final Action perhaps should be asserting that this "machine" inherently shows the prompts.

Appellant thus points to MPEP § 2112, which states:

EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE TENDING TO SHOW INHERENCY.

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art.

**RESPONSE TO OBVIOUSNESS REJECTIONS
CLAIMS 4 - 6**

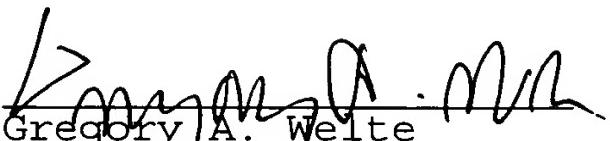
These claims are considered patentable, based on their parent claims.

09/780,696
Art Unit 3624
Docket no. 8771.00

CONCLUSION

Appellant requests that the Board reverse the rejections,
and pass all claims to issue.

Respectfully submitted,


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ATTACHMENTS: -- CLAIMS APPENDIX,
-- STATEMENT THAT NO EVIDENCE APPENDIX IS
ATTACHED,
and
-- STATEMENT THAT NO RELATED PROCEEDINGS APPENDIX
IS ATTACHED

09/780,696
Art Unit 3624
Docket no. 8771.00

8. CLAIMS APPENDIX

1. A method of conducting a transaction from within a vehicle, the method comprising the steps of:

locating the vehicle adjacent a transaction terminal; transferring one or more computer programs from the transaction terminal to an in-car data entry facility maintained within the vehicle, which programs generate a user interface in the entry facility;

entering user instructions into the in-car data entry facility; and

transmitting the user instructions locally to the terminal for execution by the terminal.

2. A method in accordance with claim 1, further comprising the step of identifying the user.

3. A method in accordance with claim 1, further including the steps of transmitting data locally from the terminal to the vehicle, and displaying a part of the data on an in-car display located within the vehicle.

4. A method in accordance with claim 1, further comprising the step of retrieving cash or other valuable media dispensed

09/780,696
Art Unit 3624
Docket no. 8771.00

from the terminal.

5. A method in accordance with claim 1, further comprising the step of uploading electronic valuable media to a memory storage device located within the vehicle.

6. A method in accordance with claim 1, further comprising the step of downloading electronic valuable media to the terminal from a memory storage device.

8. An in-car apparatus to be provided within a vehicle for user interfacing with a transaction terminal, the apparatus comprising:

- . means for interacting with a user;
- means for receiving a computer program from the transaction terminal which generates an interface in the apparatus; and
- means for transmitting data locally to a transaction terminal situated adjacent the apparatus.

10. An apparatus in accordance with claim 8, further comprising memory storage means for recording data.

21. A method, comprising:

09/780,696
Art Unit 3624
Docket no. 8771.00

- a) maintaining a wireless communication device within a vehicle;
- b) positioning the vehicle near an Automated Teller Machine, ATM;
- c) establishing wireless communication between the wireless device and the ATM;
- d) entering identification data into the wireless device, which data allows the ATM to verify identity of a user; and
- e) if the ATM verifies the user, proceeding with a financial transaction.

22. Method according to claim 21, and further comprising:

- f) transferring one or more computer programs from the ATM to the device, which programs generate an interface for the user.

23. Method according to claim 21, wherein the identification data is obtained from a card presented to the device.

24. Method according to claim 21, wherein the identification data is obtained from a keypad operated by the user.

09/780,696
Art Unit 3624
Docket no. 8771.00

25. A method, comprising consisting essentially of the steps of:

- a) maintaining a wireless communication device within a vehicle, said device comprising a keypad and a card reader;
- b) positioning the vehicle near an Automated Teller Machine, ATM;
- c) establishing wireless communication between the wireless device and the ATM and transferring one or more computer programs from the ATM to the device, which programs generate an interface for the user;
- d) inserting a card into the card reader in response to a prompt issued by the interface;
- e) entering a PIN into the keypad in response to a prompt issued by the interface;
- f) relaying data from the card, and the PIN, to the ATM; and
- g) if the card and the PIN are accepted by the ATM, proceeding with a financial transaction.

27. Method according to claim 1, and further comprising:
locating the vehicle adjacent a second transaction terminal;

09/780,696
Art Unit 3624
Docket no. 8771.00

transferring one or more second computer programs from the transaction terminal to an in-car data entry facility maintained within the vehicle, which programs generate a second user interface, different from said interface, in the entry facility;

entering user instructions into the in-car data entry facility; and

transmitting the user instructions locally to the terminal for execution by the terminal.

09/780,696
Art Unit 3624
Docket no. 8771.00

9. EVIDENCE APPENDIX

None.

09/780,696
Art Unit 3624
Docket no. 8771.00

10. RELATED PROCEEDINGS APPENDIX

None.